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EXAMINER

COSIMANO, EDWARD R

ART UNIT PAPER NUMBER

3629

DATE MAILED: 08/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/708,913

Applicant(s)

LEON, J. P.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/7/00 & 4/2/01.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-65 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5,6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

1. Applicant should note the changes to patent practice and procedure:

A) effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997;

B) effective November 07, 2000 as published in the Federal Register, Vol 65, No. 54603, September 08, 2000; and

C) Amendment in revised format, Vol. 1267 of the Official Gazette published February 25, 2003.

2. The numbering of claims is not in accordance with 37 CFR § 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

2.1 Misnumbered claims 59-66 have been renumbered as 58-65, since the claims as filed lack a claim number 58.3. The use of various trademark(s) for example: Yahoo®, Macintosh® PC's, Apple Computer, Inc., Intel®, Netscape Navigator®, Internet Explorer®, Microsoft Corporation, Windows®, Java®, have been noted in various paragraphs on pages 6, 7, 8 & 11.

3.1 Any trademarks should be capitalized wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

4. The drawings are objected to because

A) the following errors have been noted in the drawings:

(1) The drawings are objected to as failing to comply with 37 CFR § 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

(a) 704 & 706 as disclosed in:

(a)(1) the paragraphs between page 17, line 1, and page 20, line 17, , "Fig. 7 depicts ... servers 704 (with associated

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cryptographic modules 706) ... server 704 via an ODBC interface.”; and

(a)(2) the paragraphs between page 23, line 23, and page 27, line 19, “If it determined ... data structure may include:”.

(2) the drawings lack fig. 10 as disclosed in the paragraph bridging pages 25-26, “PSMD server 704 ... explained below with respect to Fig. 10.”.

4.1 A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

4.2 Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

5. The disclosure is objected to because of the following informalities:

A) applicant must update:

(1) the application data on page(s) 1-2, 11, 13, 14 & 15, with the current status of each of the referenced applications, e.g., --now abandoned--, or --now patent #?--, or --which is abandoned and now serial number #?--, etc.

B) as required by 37 CFR § 1.84(p(5)) and 37 CFR § 1.121(e) the specification lacks an explicit reference to the nature of:

(1) reference legend(s):

(a) 200, 204, 206, 213 & 214 of fig. 2 as disclosed in the paragraphs between page 8, line 29, and page 14, line 27, “Referring to Figs. 2 and 3, ... scope of the claims which set forth the invention.”;

(b) 232-1, 232-2, 704-1, 704-2, 706-1 & 706-2 of fig. 7 as disclosed in the paragraphs :

(b)(1) between page 17, line 1, and page 20, line 17, ,”Fig. 7 depicts ... servers 704 (with associated cryptographic modules 706) ... server 704 via an ODBC interface.”; and

(b)(2) between page 23, line 23, and page 27, line 19, "If it determined ... data structure may include:"; and

(c) 812 of fig. 8 in the paragraph at page 23, lines 23-30, "If it is determined ... the work among PSMD servers 704.".

In this regard, it is noted that merely mentioning a number with out mentioning the device or operation of the step relies on the drawing to provide support for the disclosure and not to aid in the understanding of the invention, as is the purpose of the drawings (37 CFR § 1.81(a,b)).

C) the following errors have been noted in the specification:

(1) as can be seen in fig. 7 and from the context of the disclosure:

(a) between page 17, line 1, and page 20, line 17, , "Fig. 7 depicts ... servers 704 (with associated cryptographic modules 706) ... server 704 via an ODBC interface."; and

(b) between page 23, line 23, and page 27, line 19, "If it determined ... data structure may include:";

each reference to reference number:

(a) "232" should be --232-1--, and --232-2--.

(b) "704" should be --704-1--, and --704-2--.

(c) "706" should be --706-1--, and --706-2--.

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)), § 1.121(a)-1.121(f) & § 1.121(h)-1.121(i).

7. 35 U.S.C. § 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

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7.1 Claims 13-22 & 32-41 are rejected under 35 U.S.C. § 101 because the invention as claimed is directed to non-statutory subject matter.

7.1.1 The instant claims recite a system/device, (claims 13-22 & 32-41), which has a practical application in the technological arts, and which does not merely define either a computer program, a data structure, non-functional descriptive material, (i.e. mere data) or a natural phenomenon. Hence, the instant claims merely define device that contains a series of steps that could be but are not necessarily to be performed on a computer.

7.1.2 It is further noted that applicant has not recited a specific machine since the operations recited in the claim are merely to illustrate the operations of the instant invention since these operations are not in fact implemented by a processor/computer. Hence, applicant envisions the invention as recited in claims 13-22 & 32-41 as a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure. Such a disembodied storage device is not a specific machine because:

A) it is not associated with a computer in such a way as to cause the computer to operate in a specific manner, (note In re Beauregard 35 USPQ2d 1383 (CAFC 1995) and the associated claims of U.S. Patent 5,710,578); and

B) a memory alone can not perform the functions recited within the claims.

Therefore, the recited disembodied storage device, which itself can not perform the functions recited within the claims as the invention, is inoperative and lacks utility for the purpose of the invention.

7.1.3 In view of the above, the invention recited in claims 13-22 & 32-41, merely describes an abstract idea of a disembodied storage device, i.e. memory, that stores a computer program as a non-functional data structure, since a disembodied storage device by itself can not produce a concrete and tangible result by performing the functions recited within the claims as the invention (State Street Bank & Trust Co. v. Signature Financial Group Inc. 47 USPQ2d 1596 (CAFC 1998)). Hence, claims 13-22 & 32-41 do not have a claimed practical application, since the disembodied storage device is inoperative and therefore lacks utility for the purpose of the invention.

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7.1.4 Nonfunctional descriptive material cannot render nonobvious an invention that would have otherwise been obvious. Cf. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983) (when descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability). Common situations involving nonfunctional descriptive material are:

- a computer that differs from the prior art solely with respect to nonfunctional descriptive material that cannot alter how the machine functions (i.e., the descriptive material does not reconfigure the computer), or

- a process that differs from the prior art only with respect to nonfunctional descriptive material that cannot alter how the process steps are to be performed to achieve the utility of the invention.

7.1.5 Hence, claims 13-22 & 32-41 are directed to non-statutory subject matter.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8.1 Claims 1-29, 31-39, 40-63 & 65 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Shah et al (5,822,738).

8.1.1 In regard to claims 1-3, 8-15, 20-26, 28, 32-36, 38, 42-49, 51, 52, 54, 56-58, 60-63 & 65, Shah et al ('738) discloses that an user at system (20,430,480(1),480(N): figs. 6,7) after obtaining all of the necessary information for a postage indicia formulates a request for postage and sends the request via a communications link to proxy computer (120,410: figs. 6,7). Proxy computer, which can not dispense postage, passes the request for postage to SMD (210,400: figs. 6,7). SMD (210,400), which is licensed to dispense postage by an associated carrier, for example the United States Postal Service (USPS), once the request has been validated creates a complete postage indicia based on the request. Next SMD (210,400) sends

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the postage indicia back through the proxy computer (120,410) to the user's system (20,430,480(1),480(N)). Finally the user may print the postage indicia on an item of mail.

8.1.2 In regard to claims 4, 16, 31 & 41, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which require an operating program to control the operation of the system, the system of Shah et al ('738) inherently contains a number of software components.

8.1.3 In regard to claims 5, 6, 17 & 18, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers which will automatically print the postage indicia, the system of Shah et al ('738) inherently prints the indicia with or without human intervention.

8.1.4 In regard to claims 7, 19, 27, 37, 53 & 59, since the postage dispensing system of Shah et al ('738) is implemented using a number of computers that use standard printers and not a photographic reproduction process, the system of Shah et al ('738) inherently contains a bit-map of the indicia in order to properly control the standard printer to accurately reproduce the indicia.

8.1.5 In regard to claims 9, 10, 29, 39, 50 & 55, since the postage dispensing system of Shah et al ('738) uses an indicia that is combination of fixed or background information and variable information, e.g. the date, postage, and verification data, the system of Shah et al ('738) inherently combines these two sources of information to complete the postage indicia.

9. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability

under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

9.1 Claims 30, 40 & 64 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Shah et al (5,822,738) as applied above to claims 1-29, 31-39, 40-63 & 65 in view of an inherent necessity.

9.1.1 In regard to claims 30, 40 & 64, Shah et al ('738) does not disclose using the XML communications protocol, however, Shah et al ('738) dose disclose the use of a protocol which will support the required communications between the various components of the system, therefore it would have been obvious to one of ordinary skill at the time the invention was made that the system of Shah et al ('738) could be modified to use any suitable communications protocol that would support the communications requirements of the system of Shah et al ('738) in order to accomplish the proper operation of the system of Shah et al ('738).

10. The examiner has cited prior art of interest, for example:

A) Kara (WO 98/14907) and the Business Wire article which disclose obtaining postage indicia from a central location over an communications link, such as the internet.

11. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss, can be reached on (703)-308-2702. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113.

12.1 The fax phone number for UNOFFICIAL/DRAFT FAXES is (703) 746-7240.

12.2 The fax phone number for OFFICIAL FAXES is (703) 872-9306.

12.3 The fax phone number for AFTER FINAL FAXES is (703) 872-9306.

08/11/03


Edward R. Cosimano
Primary Examiner A.U. 3629